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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,810	02/09/2004	Clifford E. Gammons	29126.00	9244
22465	7590	01/04/2006	EXAMINER	
PITTS AND BRITTIAN P C			PICKETT, JOHN G	
P O BOX 51295			ART UNIT	
KNOXVILLE, TN 37950-1295			PAPER NUMBER	

3728

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

E

Office Action Summary	Application No.	Applicant(s)	
	10/774,810	GAMMONS, CLIFFORD E.	
	Examiner	Art Unit	
	Gregory Pickett	3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment submitted 21 October 2005. Claims 1-20 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. In light of the applicant's amendment to claims 5, 11, and 13, the objection to the drawings is hereby withdrawn.

Claim Rejections - 35 USC § 112

4. Claims 11-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "said second shoulder curved transition" in line 21. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-16 are dependent on claim 11 and are rejected for the above reason.

- Claim 17 recites the limitation "respective linear side portions" in lines 13 and 14-
15. There is insufficient antecedent basis for this limitation in the claim.

Claims 18-20 are dependent on claim 17 and are rejected for the above reason.

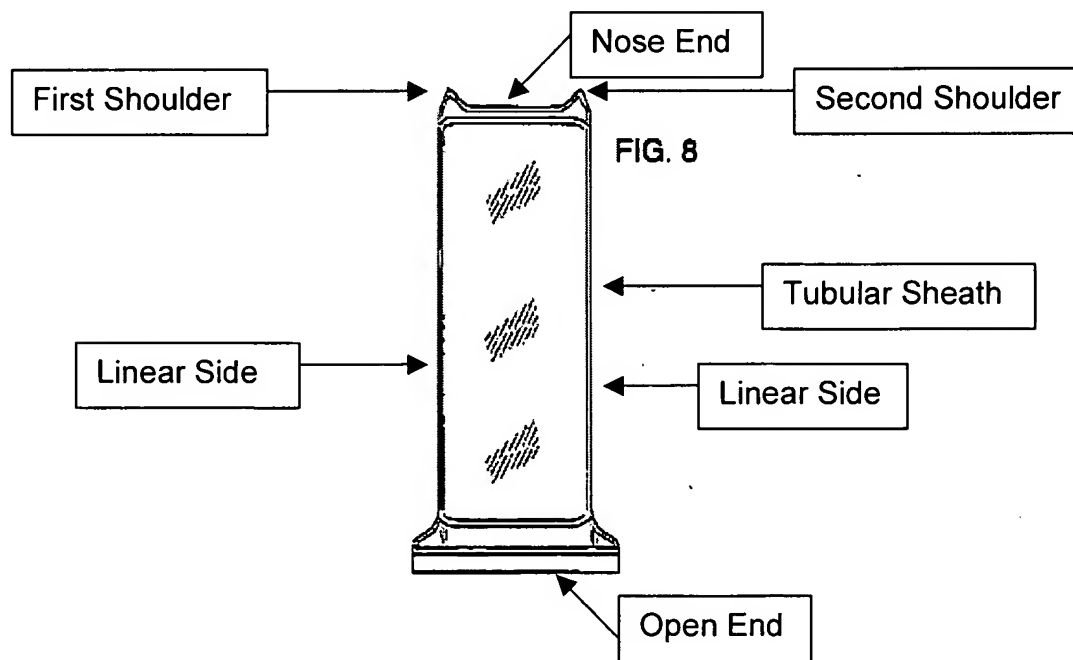
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Further, claim 19 recites the limitation "said carrier" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

5. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacGilvary et al (Des. 369,607; hereinafter MacGilvary; previously provided) in view of King (US 4,901,852; previously provided).

Claim 17: MacGilvary discloses a sheath (see Figures 7-11) with an open end and a nose end (see below). It is readily apparent from the drawings, and therefore obvious to one of ordinary skill in the art, that the sheath is formed from two sheets of like contour joined at a peripheral connecting seal (see Figures 9, 10, and 11). Further, one of ordinary skill in the art would have also recognized that the material would need to be flexible since the open end is movable from an open position to a closed position (see Figures 7 and 11).



The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention, as can drawings in utility patents. When the reference is a utility patent, it does not matter that the feature shown is unintended or unexplained in the specification. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). MPEP § 2125.

MacGilvary discloses two shoulder portions that define uninterrupted transitions from the linear side portions to the nose end (see above). MacGilvary merely lacks the scalloped transition on the first shoulder.

King discloses scalloping **40** (see Figure 2) to protect a control of a retained device, while allowing operation of the control (Col. 3, lines 15-20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the first shoulder of MacGilvary with scalloping as taught by King in order to enable operation of any controls that may be located in the shoulder location.

Claim 18: the scalloping of King functions as claimed.

Claim 19: It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the scalloping of King on both shoulders in order to operate any controls that may be located in that position. King teaches an arcuate, convoluted scalloping.

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6. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacGilvary-King as applied to claim 17 above, and further in view of Gammons et al (US 6,224,543 B1; hereinafter Gammons; previously provided).

MacGilvary-King discloses the claimed invention except for the carrier.

Gammons discloses a carrier **26** (see Figure 2) with a sheath releasably secured to the carrier (see for example, Figures 5 and 6). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the sheath of MacGilvary-King with a carrier as taught by Gammons in order to more easily facilitate controller insertion.

Allowable Subject Matter

7. Claims 1-10 appear to define over the prior art.

8. Claims 11-16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Response to Arguments

10. Applicant's arguments with respect to claims 17-20 have been considered but are moot in view of the new ground(s) of rejection.

11. Applicant's arguments, see page 12, paragraph 4, filed 21 October 2005, with respect to Clark et al teaching away from the claimed invention, have been fully considered and are persuasive. The rejections of claims 1-10 have been withdrawn.

Conclusion

12. As the examiner presents new grounds of rejection under 35 U.S.C. 112, 2nd paragraph, this Office Action is made **NON-FINAL**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

for
Greg Pickett
Examiner
29 December 2005


David T. Fidei
Primary Examiner